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10/522,610	08/01/2005	Jose' La Rosa Ducato	P05,0024	6723
26574 7590 11/24/2009 SCHIEF HARDIN, LLP PATENT DEPARTMENT 233 S. Wacker Drive-Suite 6600 CHICAGO, IL 60606-6473				
EXAMINER				
KASSA, HILINA S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,610

Applicant(s)

LA ROSA DUCATO ET AL.

Examiner

HILINA S. KASSA

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. The amendment submitted on 08/05/2009 has been acknowledged. Claims 1-48 are cancelled and claims 49-71 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 49-71 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 49-52, 54-56, 58-63, 65-67 and 69-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohensee et al. (US Patent Number 7,218,411 B2).

(1) regarding claim 49:

As shown in figure 1, Hohensee et al. disclosed a method for enhancement with a print data processing computer of an input document data stream which comprises at least one input format file comprising format definitions and an input document data file structured in ranges and sub-ranges and containing variable data (**column 4, lines 15-24; note that the print request is accompanied by a job ticket, such as a MO:DCA Form Definition, that specifies finishing operations to be performed on the print file. the finishing operations are specified in a Form Definition using commands and parameters. The host/server 102 of the exemplary embodiment accepts the print file and job ticket, and derives a composite data stream that consists of an IPDS data stream and an encapsulated data stream that contains the printing finishing commands for the print file**), comprising the steps of:

in a control file defining finishing commands and enhancing the data stream with said finishing commands (**column 7, lines 63-67; note that the input data gets enhanced by the finishing commands. see also, column 6, lines 8-16**);

in the control file also defining levels that correspond to at least one of the ranges and the sub-ranges of the input document data file (**column 7, line 63-column 8, line 5; note that the form definition has levels corresponding to the nesting i.e. range finishing operations and the sub-portion nesting levels i.e. sub-ranges**);

in the control file also associating the finishing commands with the levels and registering which finishing commands are executed in which levels (**column 7, lines 63-67; note that form definition showing nesting finishing operations at different**

levels, also see in column 9, lines 33-34; the finishing operation is controlled by the group levels);

in the control file also associating a first of the finishing commands with one of the ranges and associating a second of the finishing commands with one of the sub-ranges (**column 10, lines 17-33; note that the first package sub-portion is initiated by the first XOH SGO command 602 that defines the level as X'80' and the operation to be X'04', "finishing operations.";**) and

using the control file, input format file, and the input document data file, automatically generating and outputting with said processing computer by a computer program module to a printing device for creating a printed document (**column 4, lines 25-32; note that the printing device receives and processes commands in order to generate the required printed output)**

an output format file that contains the finishing commands in callable groups (**column 9, lines 15-19; note that the IPDS Architecture provides two commands that are used to specified desired finishing operations**), and

an output document data file containing the variable data and group calls associated by at least one of range-by-range and sub-range-by-sub-range (**column 11, lines 15-30; note that the finishing command is applied by the range and sub-range group**).

(2) regarding claim 50:

Hohensee et al. further disclosed a method according to claim 49 wherein the output document data file is fed to a data production system that comprises said printing device and at least one device for processing of a print product at least one of before and after a printing event (**column 5, lines 7-12; note that the printing device 106 of the exemplary embodiment interprets these pre-processing and post-processing commands and performs communications via the UP.sup.3I bus 110 that corresponds to pre-processing and post-processing commands that are contained within received IPDS commands**), and wherein the finishing commands activate at least one of the devices for processing of the print product at least one of before and after said printing event (**column 5, lines 15-19; note that these pre- and post- processing devices are either physically incorporated within the same unit as the printing device 106, or they are connected to the printing device**).

(3) regarding claim 51:

Hohensee et al. further disclosed a method according to claim 49 wherein the data of the output format file and the data of the output document file are generated corresponding to one another with the computer program module (**column 4, lines 12-13; note that a print file i.e. output format file, containing documents in MO:DCA format, also called Advanced Function Presentation (AFP) format, is generated on workstation**).

(4) regarding claim 52:

Hohensee et al. further disclosed a method according to claim 49 wherein at least one of said input document data stream and an output document data stream comprising said output document data file is resource-structured and comprises a page description language data stream **(column 6, lines 4-6; note that finishing operation nesting rules at the PDL level is disclosed).**

(5) regarding claim 54:

Hohensee et al. further disclosed a method according to claim 52 wherein the input and output format files are respectively a formdef file, and the computer program module provides the output formdef file with modified medium maps relative to the input formdef file **(column 6, lines 39-46; note that if more than one operation is specified with the same scope, e.g. if two operations are specified at the medium-map level, the order of the Finishing Operation triplets--whether specified on the same Medium Finishing Control (MFC) structured field or on different MFCs--defines the order of the nesting).**

(6) regarding claim 55:

Hohensee et al. further disclosed a method according to claim 52 wherein the output document file comprises a print file with variable print data, and the computer program module enhances the variable data with calls of medium maps of the output formdef file **(column 6, lines 65-67; note that each Medium Map that is to generate such finishing must specify the operation explicitly).**

(7) regarding claim 56:

Hohensee et al. further disclosed a method according to claim 49 wherein a non-resource-structured file is read in and converted into a resource-structured input data file (**column 4, lines 15-18; note that the print request is accompanied by a job ticket, such as a MO:DCA Form Definition, that specifies finishing operations to be performed on the print file**).

(8) regarding claim 58:

Hohensee et al. further disclosed a method according to claim 56 wherein the same computer program module as is used to prepare the resource-structured input file is used to convert the non-resource-structured file (**column 4, lines 15-20**).

(9) regarding claim 70:

Hohensee et al. further disclosed a system according to claim 60 wherein said processing computer comprises a computer program module providing a graphical user interface by which a user can specify the levels within the data stream and can associate the finishing commands with the levels to create the control file (**column 3, lines 20-23; note that the exemplary embodiment includes one or more workstations 114 that are used by graphic designers or users with other skills to define part or all of the document to print**).

5. The proposed rejection of Hohensee et al., explained in the method claims 49-52, 54-56 and 58, renders obvious the system and computer program product of claims 59, 60-63, 65-67 and 69 because the method is performed based on a system as explained in figures 1-2 and the computer program is implement as shown in figures 4-6 in order to perform the steps as discussed above. Thus, the arguments similar to that presented above for claims 49-52, 54-56 and 58 are equally applicable to claims 59, 60-63, 65-67 and 69.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohensee et al. (US Patent Number 7,218,411 B2) in view of MO:DCA Reference (IBM Publication SC31-6802-05, see IDS).

(1) regarding claim 53:

Hohensee et al. disclose all of the subject mater as described as above except for specifically teaching disclosed wherein at least one of said input document data stream and an output document data stream comprising said output document data file

is resource-structured and comprises at least one of an XML, PPML, PCL, and PostScript data stream.

However, MO:DCA Reference teaches wherein at least one of a resource-structured input document data stream and a resource-structured output document data stream comprises at least one of an XML, PPML, PCL and PostScript data stream **(page 9, chapter 2, paragraph [0003], lines 4-6; note that MO:DCA documents are TIFF, EPS i.e. PostScript and single-page PDF).**

Hohensee et al. and MO:DCA Reference are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art wherein a non-resource-structured file is read in and converted into a resource-structured input data file. The suggestion/motivation for doing so would have been in order to efficiently dictate the processing functions of mixed object documents (chapter 2, paragraph [0001]). Therefore, it would have been obvious to combine Hohensee et al. with AFP and Line Data Reference to obtain the invention as specified in claim 53.

8. The proposed combination of Hohensee et al. and MO:DCA Reference, explained in rejection of the method claim 53, renders obvious the system claim 64 because the method is performed based on a system as explained in figures 1-2 in order to perform the steps as discussed above. Thus, the arguments similar to that presented above for claim 53 is equally applicable to claim 64.

9. Claims 57 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohensee et al. (US Patent Number 7,218,411 B2) and further in view of AFP and Line Data Reference (IBM Publication S544-3884-02, see IDS).

(1) regarding claim 57:

Hohensee et al. disclosed all of the subject matter as described as above except for specifically teaching a method according to claim 56 wherein the non-resource-structured file comprises a line data file.

However, AFP and Line Data Reference teaches wherein the non-resource-structured file comprises a line data file (**page 5, column 2, lines 1-4; note that line data is not already in MO:DCA i.e. resource-structure**).

Nakagiri et al. and AFP and Line Data Reference are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art wherein the non-resource-structured file comprises a line data file. The suggestion/motivation for doing so would have been in order to acquire a device independent data structure (chapter 2, paragraph [0001]). Therefore, it would have been obvious to combine Hohensee et al. with AFP and Line Data Reference to obtain the invention as specified in claim 57.

10. The proposed combination of Hohensee et al. and AFP and Line Data Reference, explained in rejection of the method claim 57, renders obvious the system

claim 68 because the method is performed based on a system as explained in figures 1-2 in order to perform the steps as discussed above. Thus, the arguments similar to that presented above for claim 57 is equally applicable to claim 68.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Hilina Kassa whose telephone number is (571) 270-1676.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore could be reached at (571) 272- 7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR system, see <http://pari-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hilina S Kassa/
Examiner, Art Unit 2625
November 19, 2009

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625